

1	MATTHEW D. POWERS (Bar No. 104795)	·	
2	matthew.powers@weil.com EDWARD R. REINES (Bar No. 135960)		
3	edward.reines@weil.com SONAL N. MEHTA (Bar No. 222086)		
4	sonal.mehta@weil.com WEIL, GOTSHAL & MANGES LLP		
5	Silicon Valley Office 201 Redwood Shores Parkway		
6	Redwood Shores, CA 94065 Telephone: (650) 802-3000		
7	Facsimile: (650) 802-3100		
8	Attorneys for Apple, Inc.		
9	UNITED STATES DISTRICT COURT		
10	NORTHERN DISTRICT OF CALIFORNIA		
11	SAN JOSE I	DIVISION	
12	ELAN MICROELECTRONICS CORPORATION,	Case No. C-09-01531 RS	
13	Plaintiff and Counterclaim	APPLE, INC.'S FIRST AMENDED ANSWER, AFFIRMATIVE DEFENSES,	
14	Defendant,	AND COUNTERCLAIMS TO ELAN MICROELECTRONICS	
15	v.	CORPORATION'S COMPLAINT FOR PATENT INFRINGEMENT	
16	APPLE, INC.,	Hon. Richard Seeborg	
17	Defendant and Counterclaim Plaintiff.	Demand for Jury Trial	
18		Demand for July Thai	
19			
20	Defendant Apple, Inc. ("Apple") b	by and through its undersigned counsel, hereby	
21	responds to Plaintiff Elan Microelectronics C	Corporation's ("Elan") Complaint for Patent	
22	Infringement ("Complaint") as follows:		
23	I.		
24	ANSV	VER	
25	PARTIES		
26	1. Apple is without knowledge or information sufficient to form a belief as to		
27	the truth of the statements in Paragraph 1 of the	ne Complaint, and, on that basis, denies those	
28	allegations.		
	APPLE, FIRST AMENDED ANSWER, AFFIRMATIVE DEFENSES, AND COUNTERCLAIMS	CASE NO. C-09-01531 RS	

- 2. Apple admits that U.S. Patent No. 5,825,352 ("the '352 patent") states on its face that it is entitled "Multiple Finger Contact Sending Method for Emulating Mouse Buttons and Mouse Operations on a Touch Sensor Pad." Apple is without knowledge or information sufficient to form a belief as to the truth of the allegations concerning Elan's purported ownership of all right and title to the '352 patent and, therefore, denies those allegations. Except as so expressly admitted herein, Apple denies the allegations in Paragraph 2 of the Complaint.
- 3. Apple admits that U.S. Patent No. 7,274,353 ("the '353 patent") states on its face that it is entitled "Capacitive Touchpad Integrated with Key and Handwriting Functions." Apple is without knowledge or information sufficient to form a belief as to the truth of the allegations concerning Elan's purported ownership of all right and title to the '353 patent and, therefore, denies those allegations. Except as so expressly admitted herein, Apple denies the allegations in Paragraph 3 of the Complaint.
 - 4. Apple admits the allegations in Paragraph 4 of the Complaint.

JURISDICTION AND VENUE

- 5. Apple admits that Elan's Complaint purports to be an action that arises under the patent laws of the United States, 35 U.S.C. § 1 *et seq.*, but denies any wrongdoing or liability on its own behalf for the reasons stated herein. Apple admits that this Court has subject matter jurisdiction under 28 U.S.C. §§ 1331 and 1338(a). Except as so expressly admitted herein, Apple denies the allegations in Paragraph 5 of the Complaint.
- 6. Apple admits that it resides in this district and has a regular place of business in this district. Apple denies that it has committed any acts of infringement within this district and specifically denies any wrongdoing, infringement, inducement of infringement or contribution to infringement. Apple admits that venue is proper as to Apple in this District pursuant to 28 U.S.C. §§ 1391(b) and 1400(b). Except as so expressly admitted herein, Apple denies the allegations in Paragraph 6 of the Complaint.

THE DISPUTE

- 7. Apple denies the allegations in Paragraph 7 of the Complaint.
- 8. Apple denies the allegations in Paragraph 8 of the Complaint.

1	9. Apple admits that it designs, markets and sells computer and consumer
2	electronics products including touch-sensitive input devices. Apple admits that it does or has
3	designed, marketed, and sold the Apple iBook, PowerBook and MacBook portable computers,
4	iPhone mobile phones and iPod Touch digital medial player devices, which do or have included
5	touch-sensitive input devices. Except as so expressly admitted herein, Apple denies the
6	allegations in Paragraph 9 of the Complaint.
7	FIRST CLAIM
8	10. Apple refers to and incorporates herein its answers as provided in
9	Paragraphs 1-9 above.
10	11. Apple denies the allegations in Paragraph 11 of the Complaint.
11	12. Apple denies the allegations in Paragraph 12 of the Complaint.
12	13. Apple denies the allegations in Paragraph 13 of the Complaint.
13	14. Apple denies the allegations in Paragraph 14 of the Complaint.
14	15. Apple denies the allegations in Paragraph 15 of the Complaint.
15	SECOND CLAIM
16	16. Apple refers to and incorporates herein its answers as provided in
17	Paragraphs 1-15 above.
18	17. Apple denies the allegations in Paragraph 17 of the Complaint.
19	18. Apple denies the allegations in Paragraph 18 of the Complaint.
20	19. Apple denies the allegations in Paragraph 19 of the Complaint.
21	20. Apple denies the allegations in Paragraph 20 of the Complaint.
22	21. Apple denies the allegations in Paragraph 21 of the Complaint.
23	PRAYER FOR RELIEF
24	22. Apple denies that Elan is entitled to any of the relief sought in its prayer for
25	relief. Apple has not directly or indirectly infringed the '352 and '353 patents, either literally or
26	by the doctrine of equivalents, willfully or otherwise. Elan is not entitled to recover statutory
27	damages, compensatory damages, enhanced damages, an accounting, injunctive relief, costs, fees,
28	

1	interest, or any other type of recovery from Apple. Elan's prayer should, therefore, be denied in	
2	its entirety and with prejudice, and Elan should take nothing.	
3	DEMAND FOR JURY TRIAL	
4	23. Apple does not object to a trial by jury on all issues so triable.	
5	II.	
6	DEFENSES	
7	As and for its affirmative defenses, Apple alleges as follows:	
8	FIRST DEFENSE – NON-INFRINGEMENT	
9	24. Apple does not infringe and has not directly or indirectly infringed any	
10	claims of the '352 and '353 patents, either literally or under the doctrine of equivalents, willfully	
11	or otherwise.	
12	SECOND DEFENSE – INVALIDITY	
13	25. Elan's alleged claims for infringement of the '352 and '353 patents are	
14	barred because each and every claim of the '352 and '353 patents is invalid for failure to comply	
15	with the requirements of Title 35 of the United States Code, including but not limited to	
16	Sections 101, 102, 103, and/or 112.	
17	THIRD DEFENSE – LACHES	
18	26. Elan's claims for relief are barred in whole or in part by the doctrine of	
19	laches.	
20	FOURTH DEFENSE – ESTOPPEL	
21	27. Elan's claims for relief are barred in whole or in part by the doctrine of	
22	equitable estoppel.	
23	FIFTH DEFENSE – STATUTE OF LIMITATIONS	
24	28. To the extent Elan seeks damages for alleged infringement more than six	
25	years prior to filing of this action, the relief sought by Elan is barred by 35 U.S.C. § 286.	
26		
27		
28		
1	ı	

1	SIXTH DEFENSE – NOTICE
2	29. To the extent Elan seeks damages for alleged infringement prior to its
3	giving actual or constructive notice of the '352 and '353 patents to Apple, the relief sought by
4	Elan is barred by 35 U.S.C. § 287.
5	SEVENTH DEFENSE – NO INJUNCTIVE RELIEF
6	30. To the extent Elan seeks injunctive relief for alleged infringement, the
7	relief sought by Elan is unavailable because any alleged injury to Elan is not immediate or
8	irreparable and because Elan has an adequate remedy at law for any alleged injury.
9	III.
10	COUNTERCLAIMS
11	Counterclaim-Plaintiff Apple counterclaims against Counterclaim-Defendant Elan
12	as follows:
13	PARTIES
14	31. Apple is a corporation organized under the laws of the State of California
15	and having a principal place of business at 1 Infinite Loop, Cupertino, CA 95014.
16	32. Elan alleges that it is a corporation organized under the laws of Taiwan
17	R.O.C. with a principal place of business at No. 12, Innovation 1st Road, Science Based
18	Industrial Park, Hsinchu Taiwan R.O.C.
19	JURISDICTION AND VENUE
20	33. These counterclaims arise under Title 35 of the United States Code. The
21	Court has subject matter jurisdiction over these counterclaims pursuant to 28 U.S.C. §§ 1331,
22	1338(a), 2201, and 2202.
23	34. Elan is subject to personal jurisdiction in this district arising out of its
24	systematic and continuous contacts with this district and its purposeful acts and/or transactions
25	directed toward this district. Such contacts include without limitation Elan's past and ongoing
26	infringing conduct in this district, Elan's bringing of this lawsuit in this district, and, on
27	information and belief, Elan's presence and conduct of business in this district through ELAN
28	Information Technology Group, operating in Cupertino, California 95015.

1	35. Venue is proper in this judicial district under 28 U.S.C. § 1391.
2	FIRST COUNTERCLAIM - DECLARATORY JUDGMENT
3	'352 PATENT
4	36. Apple incorporates herein by reference the allegations of paragraphs 1 - 35
5	of this Answer, Affirmative Defenses and Counterclaims ("Answer").
6	37. Apple counterclaims against Elan pursuant to the patent laws of the United
7	States, Title 35 of the United States Code, and the Declaratory Judgments Act, 28 U.S.C. §§ 2201
8	and 2202.
9	38. In its Complaint, Elan alleges that Apple is now and has been directly
10	and/or indirectly infringing the '352 patent by the sale of at least its iBook, PowerBook,
11	MacBook, iPhone and iPod Touch products.
12	39. An actual controversy exists between Elan and Apple by virtue of the
13	allegations of Elan's Complaint and Apple's Answer as to the validity and infringement of the
14	'352 patent.
15	40. The '352 patent is invalid and not infringed, as set forth in paragraphs 24
16	through 30 above.
17	41. Apple is entitled to judgment that the '352 patent is invalid and not
18	infringed.
19	SECOND COUNTERCLAIM – DECLARATORY JUDGMENT
20	'353 PATENT
21	42. Apple incorporates herein by reference the allegations of paragraphs 1 - 41
22	of this Answer.
23	43. Apple counterclaims against Elan pursuant to the patent laws of the United
24	States, Title 35 of the United States Code, and the Declaratory Judgments Act, 28 U.S.C. §§ 2201
25	and 2202.
26	44. In its Complaint, Elan alleges that Apple is now and has been directly
27	and/or indirectly infringing the '353 patent by the sale of its iPhone and iPod Touch products.
28	
	ADDLE DIDCT AMENDED ANSWED ADDIMATIVE CASE NO C.00.01531 RS

1	45. An actual controversy exists between Elan and Apple by virtue of the	
2	allegations of Elan's Complaint and Apple's Answer as to the validity and infringement of the	
3	'353 patent.	
4	46. The '353 patent is invalid and not infringed, as set forth in paragraphs 24	
5	through 30 above.	
6	47. Apple is entitled to judgment that the '353 patent is invalid and not	
7	infringed.	
8	THIRD COUNTERCLAIM – PATENT INFRINGEMENT	
9	'218 PATENT	
10	48. Apple incorporates herein by reference the allegations of paragraphs 1 - 47	
11	of this Answer.	
12	49. Apple is the owner of the entire right, title and interest in and to U.S. Patent	
13	No. 5,764,218 ("the '218 patent") entitled "Method And Apparatus For Contacting A Touch-	
14	Sensitive Cursor-Controlling Input Device To Generate Button Values," which was duly and	
15	legally issued on June 9, 1998 in the name of inventors Mark A. Della Bona, Jonathan Dorfman	
16	and Jay F. Hamlin. A copy of the '218 patent is attached as Exhibit A hereto.	
17	50. Upon information and belief, Elan has been and is currently, directly and/or	
18	indirectly, infringing, in violation of 35 U.S.C. § 271, the '218 patent through its design,	
19	marketing, manufacture and/or sale of touch-sensitive input devices or touchpads, including but	
20	not limited to the Smart-Pad.	
21	51. Apple has suffered, and will continue to suffer, irreparable injury as a	
22	result of Elan's infringement. Pursuant to 35 U.S.C. §§ 283 and 284, Apple is entitled to	
23	damages for infringement and to a permanent injunction against further infringement.	
24	52. This case is exceptional, and therefore, Apple is entitled to attorneys' fees	
25	pursuant to 35 U.S.C. § 285.	
26		
27		

28

FOURTH COUNTERCLAIM - PATENT INFRINGEMENT 1 **'659 PATENT** 2 Apple incorporates herein by reference the allegations of paragraphs 1 - 52 3 53. of this Answer. 4 Apple is the owner of the entire right, title and interest in and to U.S. Patent 5 54. No. 7,495,659 ("the '659 patent") entitled "Touch Pad For Handheld Device," which was duly 6 and legally issued on February 24, 2009 in the name of inventors Greg Marriott, Guy Bar-Nahum, 7 8 and Steven Bollinger. A copy of the '659 patent is attached as Exhibit B hereto. Pursuant to Rule 11(b)(3) and upon information and belief, it is likely that 9 55. reasonable opportunity for further investigation or discovery will confirm that Elan has been and 10 is currently, directly and/or indirectly, infringing, in violation of 35 U.S.C. § 271, the '659 patent 11 through its design, marketing, manufacture and/or sale of touch-sensitive input devices or 12 13 touchpads, including but not limited to the Smart-Pad. Apple has suffered, and will continue to suffer, irreparable injury as a 14 56. result of Elan's infringement. Pursuant to 35 U.S.C. §§ 283 and 284, Apple is entitled to 15 damages for infringement and to a permanent injunction against further infringement. 16 17 57. This case is exceptional, and therefore, Apple is entitled to attorneys' fees 18 pursuant to 35 U.S.C. § 285. FIFTH COUNTERCLAIM - PATENT INFRINGEMENT 19 **'929 PATENT** 20 Apple incorporates herein by reference the allegations of paragraphs 1 - 57 58. 21 of this Answer. 22 Apple is the owner of the entire right, title and interest in and to U.S. Patent 59. 23 No. 6,933,929 ("the '929 patent") entitled "Housing For A Computing Device," which was duly 24 and legally issued on August 23, 2005 in the name of inventor Chris J. Novak. A copy of the 25 26 '929 patent is attached as Exhibit C hereto. Pursuant to Rule 11(b)(3) and upon information and belief, it is likely that 27 60. reasonable opportunity for further investigation or discovery will confirm that Elan has been and 28

1	is currently, directly and/or indirectly, infringing, in violation of 35 U.S.C. § 271, the '929 patent
2	through its design, marketing, manufacture and/or sale of touch-sensitive input devices or
3	touchpads, including but not limited to the Smart-Pad.
4	61. Apple has suffered, and will continue to suffer, irreparable injury as a
5	result of Elan's infringement. Pursuant to 35 U.S.C. §§ 283 and 284, Apple is entitled to
6	damages for infringement and to a permanent injunction against further infringement.
7	62. This case is exceptional, and therefore, Apple is entitled to attorneys' fees
8	pursuant to 35 U.S.C. § 285.
9	DEMAND FOR JURY TRIAL
10	63. Pursuant to Rule 38 of the Federal Rules of Civil Procedure, Apple hereby
1	demands a trial by jury on all issues so triable.
12:	PRAYER FOR RELIEF
13	WHEREFORE, Apple prays for judgment as follows on Elan's Complaint and or
4	Apple's Answer, Affirmative Defenses and Counterclaims:
15	A. That Elan's Complaint be dismissed with prejudice and that Elan take
ا6	nothing;
17	B. That judgment be entered in favor of Apple against Elan on Elan's
18	Complaint;
9	C. For entry of an Order declaring each and every claim of the '352 and '353
20	patents invalid and not infringed by Apple;
21	D. For entry of an Order declaring that Elan has infringed, directly or
22	indirectly, the '218, '659 and '929 patents under 35 U.S.C. § 271;
23	E. That Elan, its officers, agents, servants, employees, attorneys and those
24	persons in active concert or participation with any of them, be preliminarily
25	and permanently restrained and enjoined from directly and indirectly
26	infringing the '218, '659 and '929 patents;
27	F. That Elan be required to pay damages to compensate Apple for Elan's
28	infringement pursuant to 35 U.S.C. § 284;
	II

	Case5:09-cv-01	1531-RS Document15 Filed07/01/09 Page10 of 10
1	G.	An assessment of pre-judgment and post-judgment interest and costs
2		against Elan, together with an award of such interest and costs;
3	Н.	That pursuant to 35 U.S.C. § 285 and/or other applicable laws, Elan's
4		conduct be found to render this an exceptional case and that Apple be
5		awarded its attorneys' fees incurred in connection with this action;
6	I.	That Elan be required to pay Apple's costs of suit;
7	J.	That Apple be awarded such other and further relief as the court may deem
8		just and proper.
9		
10	Dated: July 1, 2009	WEIL, GOTSHAL & MANGES LLP
11		
12	4. ⁴	By:/s/ Edward R. Reines
13	:	EDWARD R. REINES edward.reines@weil.com
14		Attorneys for Defendant and
15	v i	Counterclaim Plaintiff Apple, Inc.
16		
17		
18		
19		
20		
21		
22		
23		
24		
25		
26		
27		
28		